Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ROBERT J. TORRES

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Appeal No. 1999-1691
Application 08/531,812

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ON BRIEF

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Before THOMAS, HAIRSTON and KRASS, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1-18.

Representative claim 1 is reproduced below:

1. A method, performed in a data processing system, for creating dynamically constructed integration menus, the method comprising the computer implemented steps of:

storing, in a key programs list, both an executable filename and an associated menu item for each of a plurality of first application programs;

installing a menu item for each of a plurality of such first application programs of the key programs list into a menu of a second application program in response to the opening of the second application program; and

executing one of the first application programs in response to the selection within the second application program of the menu item associated with that first application program, which menu item was installed into a menu of a second application program in response to the opening of the second application program.

The following references are relied on by the examiner:

Allen et al. (Allen)	5,500,936	Mar. 19, 1996 (filing date Mar. 12, 1993)
Padawer et al. (Padawer)	5,220,675	Jun. 15, 1993

Claims 1, 5-7, 11-13, 17 and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Padawer. Claims 2-4, 8-10 and 14-16 stand rejected under 35 U.S.C. §103. As evidence of obviousness, the examiner relies upon Allen in view of Padawer.

OPINION

We reverse generally for the reasons set forth by appellant at pages 5-10 of the brief.

The preamble of representative independent claim 1 on appeal requires the creation of dynamically constructed integration menus in a data processing system. This

is implemented in the body of the claim in part by installing a menu item for each of a plurality of first application programs into a menu of a second application program "in response to the opening of the second application program." This operation is repeated in the execution clause where it is stated that the menu item was installed into a menu of the second application program in response to the opening of the second application program. Comparable limitations are found in independent claims 1, 7 and 13 on appeal.

In Padawer no menu item for program No. 1 is installed in program No. 2 upon merely opening program No. 2 as required by representative independent claim 1 on appeal. The "add" command of Figures 4 and 5 of Padawer permits the user to manually add another program menu item to the user defined custom menu item block 114 in Figure 2, for example, as done in the example in Figure 6. This is not done by merely opening program No. 2. Because the body of representative independent claim 1 on appeal, and each independent claim on appeal as well, effects the dynamic construction of integrated menus as set forth in the preamble of representative independent claim 1 on appeal, the manual operation of the insertion discussed in the previous paragraph of this opinion from the noted figures in Padawer does not meet the claimed functionality within 35 U.S.C. §102. Thus, Padawer discloses only a manual method of adding menus items in response

to user input. It appears that the actual selection of the added menu item in the execution portion of each independent claim on appeal is done manually in both the claimed invention and in Padawer. However, this can only occur upon the installation of the menu item of the first program "into a menu of a second application program in response to the opening of the second application program." This operation is consistent with the depiction in disclosed Figures 2 and 4 as described in the paragraph bridging pages 11 and 12 of the disclosed invention.

Since we do not sustain the rejection under 35 U.S.C. § 102 of each independent claim 1, 7 and 13 on appeal, we reverse the rejection of all dependent claims rejected on this statutory basis. Similarly, we must reverse the rejection of the respective dependent claims under 35 U.S.C. § 103 since Allen does not cure the

above-noted defects with respect to Padawer. Therefore, the decision of the examiner rejecting the various claims on appeal under 35 U.S.C. §102 and 35 U.S.C. §103 is reversed.

REVERSED

James D. Thomas Administrative Patent Judge	))))) BOARD OF PATENT
Kenneth W. Hairston Administrative Patent Judge	)) APPEALS AND)) INTERFERENCES
Errol A. Krass Administrative Patent Judge	))

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